

### **REMARKS/ARGUMENTS**

By the foregoing amendment, claims 1, 6-8, 14, 17, 20, 23, 25 and 27-40 have been amended to clarify the claimed subject matter and/or to eliminate unnecessary limitations. Also, claims 2-5 and 26 have been cancelled. No new matter has been added. Following entry of this amendment, claims 1, 6-25 and 27-40 will be pending. Reconsideration is requested.

#### **35 U.S.C. §112 Rejections**

In the Office Action, claims 20 and 23 were rejected under 35 U.S.C. 112, second paragraph on grounds of indefiniteness. By the forgoing amendment, claims 20 and 23 have been amended to overcome these stated rejections.

#### **35 U.S.C. §102/103 Rejections**

Also in the Office Action, each of claims 1-40 were rejected under 35 U.S.C. §102 and/or §103 as being anticipated or obvious over one or more of the following references:

United States Patent No. 6,283,961 (Underwood et al.);

United States Patent No. 6,432,104 (Durgin et al.);

United States Patent No. 6,290,699 (Hall et al.); and

United States Patent Application Publication No. 2002/0002372 (Jahns et al.).

As presently amended, all claims are believed to be patentably distinguishable over Underwood et al., Durgin et al., Hall et al. and Jahns et al. alone or in combination. A non-limiting example of the presently claimed invention is shown Applicant's Figures 2, 4 and 5, reproduced below:

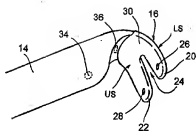


Fig. 2

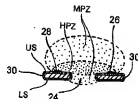


Fig. 5

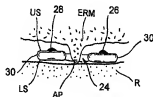


Fig. 4A

As the Examiner will note with respect to the examples of Figures 2, 4A and 5, the claimed invention provides a device that has a right foot member (22), a left foot member (20) and an open space (24) between the right and left foot members (20,22). An insulating covering is located on at least the lower surfaces (LS) of the foot members (20, 22). Electrodes (26, 28) are located on the upper surfaces (US) of the foot members (20, 22). These electrodes are useable to create an electromagnetic field that thermally cuts or coagulates tissue located above the open space (24) while not causing substantial thermal cutting and/or coagulation of tissue that is located below the lower surfaces (LS) of the right and left foot members (20,22). The tissue may protrude downwardly from an anatomical structure located above the foot members (as shown in the example of Figure 4A) or it may protrude upwardly between the foot members (as described elsewhere in the specification).

As presently amended, independent device claim 1 recites a device that comprises:

*an elongate member having a distal end;*

*a right foot member having an upper surface and a lower surface and a left foot member having an upper surface and a lower surface, the right and left foot members extending angularly from the distal end of the elongate member such that an open space exists between the right and left foot members;*

*an electrically and thermally insulating covering formed on at least the lower surfaces of the right and left foot members; and*

*an electrode on the upper surface of the right foot member; and*

*an electrode on the upper surface of the left foot member;*

*wherein the electrodes are energizable to thermally cut or coagulate tissue located above the open space located between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.*

Also, as presently amended, independent method claim 25 recites a method for selective electrosurgical cutting or coagulation of tissue comprising the steps of:

*A) inserting a device which comprises;*

*an elongate member having a distal end;*

*a right foot member having an upper surface and a lower surface and a left foot member having an upper surface and a lower surface, the right and left foot members extending angularly from the distal end of the elongate member such that an open space exists between the right and left foot members;*

*an electrode on the upper surface of the right foot member;*

*an electrode on the upper surface of the left foot member; and*

*an electrically and thermally insulating covering formed on at least the lower surfaces of the right and left foot members;*

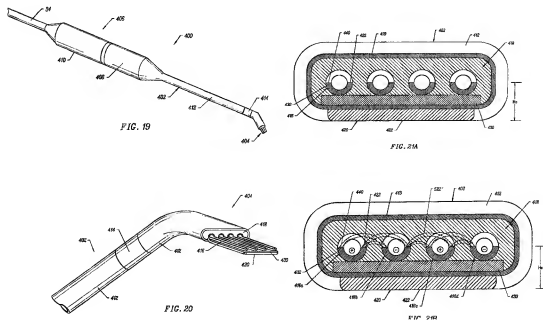
*B) positioning the device such that a mass of tissue that is to be cut or coagulated protrudes into an area located above the open space between the right and left foot members; and*

*C) energizing the electrodes to thermally cut or coagulate the mass of tissue above the open space located between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.*

Independent claims 1 and 25 are patentably distinguishable over the cited Underwood et al., Durgin et al., Hall et al. and Jahns et al. on a number of grounds. For example, none of these

references describes or suggests any device or method wherein right and left foot members having an electrically and thermally insulative coating on their lower surfaces and electrodes on their upper surfaces and an open space formed therebetween are positioned such that a mass of tissue resides above the open space. Nor do any of the cited references describe or suggest any method wherein the electrodes of such a device are energized to thermally cut or coagulate the mass of tissue above the open space located between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.

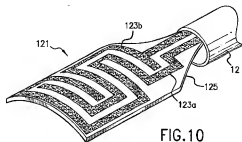
In the Office Action, the Examiner refers specifically to the embodiment shown in Figures 19-21B of Underwood et al. (reproduced below):



The Office Action states in part that this embodiment of Underwood et al. has a foot member (404) with an insulating covering formed on its lower surface (420) and “a plurality of electrodes (416) for treating tissue located on the upper side of the foot member...” However, Underwood et al. does not describe or suggest any device that has right and left foot members with an open space therebetween, an electrically and thermally insulative covering on at least the lower surfaces of the right and left foot members and electrodes on the upper surfaces of the right and

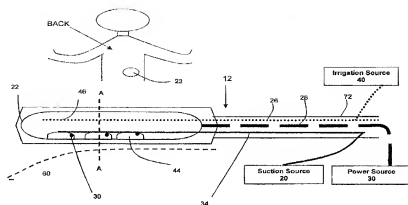
left foot members. Moreover, failing to describe or suggest these claimed elements of the device, it is axiomatic that Underwood et al. cannot describe or suggest any method wherein such a device is used to thermally cut or coagulate the mass of tissue that is located above the open space between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.

Also in the Office Action, the Examiner contends in part that Figure 10 of Durgin et al. (reproduced below) describes a device having a foot member (125) that has an upper surface having electrodes (123a, 123b) and a lower surface that is electrically and thermally insulated from tissue.



However, Durgin et al. fails to describe or suggest any device that has right and left foot members with an open space therebetween, an electrically and thermally insulative covering on at least the lower surfaces of the foot members and electrodes on the upper surfaces of the foot members. Furthermore, Durgin et al. fails to describe or suggest any method wherein such a device is used to thermally cut or coagulate the mass of tissue that is located above the open space between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.

Jahns et al. describes suction stabilized epicardial ablation devices. Figure 1 of Jahns et al. is reproduced below:



In the Office Action, the Examiner contends in part that Jahns et al. describes a device that has an elongate member (34) with a foot member (28) extending from its distal end. However, in reality, item 28 is described by Jahns et al. as a "connection for conveying energy to electrodes 22, 42 from power source 30." (Paragraph 44) Moreover, Jahns et al. clearly does not describe or suggest any structure having right and left foot members with an open space therebetween, an electrically and thermally insulative covering on at least the lower surfaces of the foot members and electrodes on the upper surfaces of the foot members. Furthermore, Jahns et al. fails to describe or suggest any method wherein such a device is used to thermally cut or coagulate the mass of tissue that is located above the open space between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.

Hall et al. describe ablation tools for forming lesions in body tissues. Figure 1 of Hall et al. is reproduced below:

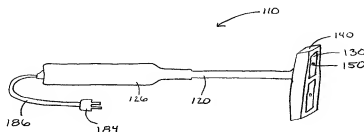


FIG. 1

In the Office Action, it is stated in part that the Hall et al. device includes an elongate member (120) connected to a handle (126), the elongate member (120) having a foot member (140) having upper and lower surfaces. However, the Hall et al. device clearly does not have right and left foot members with an open space therebetween, an electrically and thermally insulative covering on at least the lower surfaces of the foot members and electrodes on the upper surfaces of the foot members. Furthermore, Hall et al. fails to describe or suggest any method wherein such a device is used to thermally cut or coagulate the mass of tissue that is located above the open space between the right and left foot members without causing substantial thermal cutting and/or coagulation of tissue located below the lower surfaces of the right and left foot members.

Accordingly, independent claims 1 and 25 are novel and unobvious over the cited Underwood et al., Durgin et al., Hall et al. and Jahns et al. references for at least the reasons stated above and possibly other reasons not specifically articulated in these remarks. The remaining claims depend directly or indirectly from either claim 1 or claim 25 and, thus, are novel and unobvious for at least the same reasons as stated above with respect to independent claims 1 and 25.

### *Conclusion*

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and issuance of a notice of allowance is earnestly solicited. The Commissioner is hereby authorized to deduct any fee properly deemed to be due in connection with the filing of this response from Deposit Account No. 50-0878. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, the Examiner is encouraged to telephone the undersigned.

March 9, 2009

Respectfully submitted,

/Robert D. Buyan/

---

Robert D. Buyan  
Registration No. 32,460

STOUT, UXA, BUYAN & MULLINS, LLP  
4 Venture, Suite 300  
Irvine, CA 92513  
Telephone: (949)450-1750/Facsimile: (949)450-1764